

REMARKS

The Office Action of April 17, 2009 has been received and carefully reviewed. It is submitted that, by this Amendment, all bases of rejection are traversed and overcome. Upon entry of this Amendment, claims 1-25 remain in the application. Reconsideration of the claims is respectfully requested.

Claims 1-25 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The Examiner continues to assert that Applicants' specification does not provide a basis for the recitation, "only one resin." The Examiner states that "[t]he effective exclusion of other resins is therefore new matter since it is not supported by the originally filed specification" (citing *In re Grasselli*, 231 USPQ 393).

In response thereto, Applicants respectfully disagree with the Examiner that claims 1-25 fail to comply with the written description requirement under section 112, first paragraph. Under MPEP § 2163, the written description requirement requires that the application as filed should describe the complete structure of the claimed invention as a whole to establish possession of the claimed invention by the Applicants. For a claim drawn to a *single embodiment*, the MPEP provides, "If a complete structure is disclosed, the written description requirement is satisfied for that species or embodiment, and a rejection under 35 U.S.C. 112, para. 1, for lack of written description **must not** be made." (Emphasis added; see MPEP § 2163(II)(3)(a)(i).)

It is submitted that Applicants' specification as filed describes and supports all of the elements of claims 1-25, including the recitation of "only one resin" in claim 1. Applicants direct the Examiner's attention to page 2, lines 25-30 of Applicants' specification as filed, which states, "[i]n general, the ink compositions comprise... from 0.1 to 5%, preferably from 0.5 to 3% of **one or more** water-soluble polyurethanes..." (emphasis added). The foregoing recitation of Applicants'

specification includes *two separate embodiments* – 1) only one water-soluble polyurethane, and 2) more than one water-soluble polyurethane. Applicants submit that claims 1-25 are drawn to the **embodiment** of *only one* polyurethane. Further, Applicants respectfully submit that there is *no* statutory requirement that a claim must cover *all* of the embodiments disclosed in the written description. Thus, it is submitted that the claims fully meet the written description requirement.

Applicants also respectfully disagree with the Examiner's assertion that there is no language in Applicants' specification supporting the exclusion of additional resins from the ink composition. Again, Applicants' specification states that the ink composition includes *one or more* water-soluble polyurethanes. It is submitted that the conjunction "or" implicitly defines the ink composition to have a number of different, non-combinable formulations, unless a combination of formulations is explicitly stated in the specification (such as, e.g., by use of the language "combinations thereof"). For instance, the formulation of the ink composition having only one polyurethane implicitly *excludes* additional polyurethanes. Likewise, the formulation of the ink composition having more than one polyurethane implicitly *excludes* only having one. It is therefore submitted that Applicants' specification as filed does in fact support an embodiment that excludes additional resins from being used in the ink composition.

For the reasons stated above, Applicants submit that the instant 35 U.S.C. § 112, first paragraph, rejection to claims 1-25 is still erroneously based, and withdrawal of the same is respectfully requested.

Claims 1-25 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. The Examiner asserts that the claims recite ingredient amounts that do not add up to 100% and that it is unclear as to what the remainder of the composition is supposed to be.

Applicants do not acquiesce to the Examiner's instant rejection, however, in order to expedite prosecution, claim 1 has been amended to include "a balance being

water". Support for this new amendment may be found at least at page 14 of Applicants' specification as filed. Applicants therefore submit that the instant 35 U.S.C. § 112, second paragraph, rejection to claims 1-25 has been obviated in light of the foregoing amendment, and withdrawal of the same is respectfully requested.

Claims 1-10 and 13-25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Yeh, et al. (U.S. Patent Publication No. 2004/0035319) in view of Waki, et al. (WO 03/097753, an English equivalent of which is U.S. Patent Publication No. 2004/0242726). Further, claims 11 and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Yeh in view of Waki, and further in view of lu, et al. (U.S. Patent No. 6,102,998).

Submitted herewith is an affidavit pursuant to 37 C.F.R. § 1.131 signed by all of the inventors of the instant application, stating that the claimed invention of the instant application (Application Ser. No. 10/775,660) was conceived prior to the filing date (May 29, 2003) of Yeh, et al. Applicants therefore submit that the Yeh reference does not qualify as prior art, thereby obviating the Examiner's rejections enumerated above.

It is submitted that the absence of a reply to a specific rejection, issue or comment in the instant Office Action does not signify agreement with or concession of that rejection, issue or comment. Finally, nothing in this Amendment should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this Amendment, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

In summary, claims 1-25 remain in the application. It is submitted that, through this Amendment, Applicants' invention as set forth in these claims is now in a condition suitable for allowance.

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Further and favorable consideration is requested. If the Examiner believes it would expedite prosecution of the above-identified application, the Examiner is cordially invited to contact Applicants' Attorney at the below-listed telephone number.

Respectfully submitted,

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